



R2001-267

AUG 6 2001

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

, petitions for regrading her answers to questions 6, 19, and 46 of the morning section of the Registration Examination held on October 18, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On January 29, 2001 petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and

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10.7, has delegated the authority to decide requests for regrade to the Director of the Office of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers. The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

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Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional one point for morning question 6. Accordingly, petitioner has been granted an additional one point on the Examination. No credit has been awarded for morning questions 19 and 46. Petitioner's arguments for these questions are addressed individually below.

Morning question 19 reads as follows:

Please answer questions 18 and 19 based on the following facts.

You are a registered patent practitioner handling prosecution of a patent application assigned to your client, Manufacturing Company, Inc. ("ManCo"). In discussing a reply to a first, non-final Office action with the sole named inventor (I. M. Putin) on August 11, 2000, you uncover evidence that suggests an individual employed by your client may have intentionally concealed the identity of a possible joint inventor (Phil Leftout). Leftout quit ManCo after a dispute with the company president, and is currently involved in litigation against ManCo over his severance package. You learn that Leftout would be entitled to additional severance payments if he were indeed a joint inventor. You decide it is necessary to further investigate the identity of the proper inventive entity and, if the inventive entity was misidentified on the application, determine the circumstances behind this misidentification. Particularly in light of the schedules of individuals with relevant information, such an investigation would take at least three months and perhaps longer to complete. The outstanding Office action issued 5½ months ago with a 3-month shortened statutory period for reply. The examiner has raised only minor matters of form in the Office action, and you are confident the application would be in condition for allowance after you submit a reply. After discussing the matter with you, ManCo informs you they want the matter straightened out before any patent issues on the application.

19. Further assume that the application is awaiting action by the Office at the time you complete your investigation. The investigation revealed that Leftout should indeed have

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been named as a joint inventor and that the error in naming the inventive entity resulted from Putin's assistant purposely omitting Leftout from an invention disclosure form to avoid increasing the value of Leftout's severance package. Although the application was originally filed with an inventor's Declaration and an Assignment to ManCo signed by Putin as a sole inventor, Putin did not realize at the time that he was not the sole inventor of the claimed subject matter. Leftout was unaware that the application had even been prepared and filed. Thus, neither Putin nor Leftout were aware that an error had been made in the named inventive entity. There was never any deceptive intent by either Putin or Leftout concerning the error. How do you correct the named inventive entity?

(A) Promptly file a replacement declaration executed jointly by Putin and Leftout along with a cover letter explaining that Leftout was inadvertently omitted as an inventor.

(B) Because Putin's assistant purposely omitted Leftout's name, the mistake in the named inventive entity was not an error without deceptive intention and the mistake cannot be corrected.

(C) Simply file a continuation application naming Leftout and Putin as inventors and submit any necessary filing fee.

(D) Amend the application to name Leftout and Putin as joint inventors and, along with the amendment, submit a petition including a statement from Leftout that the error in inventorship occurred without deceptive intention on his part, a declaration executed by both Putin and Leftout, and all necessary fees.

(E) (C) and (D) are each an appropriate way to correct the named inventive entity.

The model answer is selection C.

Correction of inventorship may be made under the provisions of 37 C.F.R. § 1.48 or by filing a continuation application. MPEP § 201.03, second paragraph. Since the original application was filed with an inventor's declaration, correction cannot be made merely by submitting a correct declaration. See 37 C.F.R. § 1.48(a) and (f). Thus, (A) is incorrect. (B) is incorrect because there was no deceptive intention on the part of the omitted inventor, Leftout. Under the facts of the question, (D) is incorrect because it omits the written consent of ManCo required under 37 C.F.R. § 1.48(a)(4). MPEP § 201.03, under the heading "37 CFR 1.48(a)," part D. (E) is incorrect because (D) is incorrect.

Petitioner argues that answer (D) is correct. Petitioner contends that even answer

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(D) does not include the assignment required by 37 CFR §1.48(a), nevertheless it still appears to be the most correct answer since answer (D) includes the declaration executed by both inventors and the model answer (C) does not include the executed oath or declaration when filing a continuation pursuant to 37 CFR 1.63(a).

Petitioner's arguments have been fully considered but are not persuasive. 37 CFR §1.48 (a)(4) requires that if an assignment has been executed by any of the original named inventors, the written consent of the assignee must be filed with the amendment. The question specifically states that the application has been assigned to ManCo, therefore a written consent is required to correct the named inventive entity.

As to the issue of lacking the executed oath or declaration in the model answer (C), an oath or declaration is an inherent component of an application filed under 37 CFR §1.53(b) by virtue of the definition in 37 CFR §1.51(a). It is not necessary for one to assume that the application referred to in (C) is an incomplete application. Accordingly, model answer (C) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 46 reads as follows:

46. Which of the following statements regarding an applicant's duty to submit a drawing in a U.S. patent application is true?

I. The examiner may only require a drawing where the drawing is necessary for the understanding of the invention.

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II. If a drawing is not necessary for the understanding of the invention, but the case admits of illustration, the examiner may require the drawing, but the lack of a drawing in the application when filed will not affect the filing date of the application.

III. If a drawing is necessary for the understanding of an invention, but is not submitted on filing, the application cannot be given a filing date until the drawing is received by the USPTO.

- (A) I
- (B) II
- (C) III
- (D) II and III
- (E) I, II, and III

The model answer is selection (D).

35 U.S.C. § 113; MPEP § 608.02(a), under heading "Handling of Drawing Requirements Under The Second Sentence Of 35 U.S.C. 113," p.600-87. (A) is incorrect inasmuch as I is false. The examiner will normally require a drawing where the case admits of illustration. 37 C.F.R. § 1.81(c). (B) is incorrect because III is also true. (C) is incorrect because II is also true. (E) is incorrect because I is false.

Petitioner argues that answer (E) is correct. Petitioner contends that the word "normally" used in MPEP §608.02(a) indicates that an examiner cannot always require a drawing where the subject matter admits of illustration. Additionally, Petitioner argues that the statement as to "the lack of the drawing does not render the application incomplete but rather is treated as informality" under MPEP §608.02(a) is vague enough to lead a person to believe that the examiner "may only" require a drawing where the drawing is necessary for the understanding of the invention thus making Statement I correct. Finally, Petitioner's argument on Statement II is treated as moot because Petitioner reiterates its correctness.

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Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the necessity of understanding an invention is a prerequisite for an examiner to require the submission of a drawing, 37 CFR 1.81(c) allows examiners to request a drawing "whenever the nature of the subject matter sought to be patented admits of illustration by a drawing." Petitioner's argument misinterprets the meaning of MPEP §608.02(a). The language "normally" refers to the mentioned situations, e.g. where the subject matter admits of illustration by a drawing and the applicant has not furnished a drawing. The passage of MPEP §608.02(a) is not vague in that it clearly states that "wherein the drawing is not necessary for the understanding of the invention, . . . , the drawing will be normally be required by the examiner." It does not mean that an examiner cannot always require a drawing where the subject matter admits of illustration. Most clearly, MPEP §608 explicitly states that "The lack of the drawing in this situation (admits of illustration but no submission of drawing) does not render the application incomplete but rather is treated much in the same manner as an informality. The examiner should require such drawing in almost all such instances." (pp.600-86) Statement I states that only when the drawing is necessary for the understanding of the invention, can the examiner require such a drawing. Statement I is inconsistent with MPEP §608.02. Accordingly, model answer (D) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

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ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read "R. Spar", is positioned above the printed name and title of the official.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy